

### **REMARKS/ARGUMENTS**

The claims have been amended to limit the claims to a structure in which the investiture in one of the sashes is a shutter and in the other is a mesh screen, in addition to the other defining limitations.

The rejection of claims 19 and 25 – 27 under 35 U.S.C. § 103(a) as being unpatentable over Bakalar in view of Howard and Schaller et al., and further in view of Matimura, is respectfully traversed.

As an initial matter, Applicants respectfully but strongly disagree that they have in any way mischaracterized the teachings of Howard and Schaller et al. What applicants contended was that not only is there no suggestion from Bakalar to incorporate the cited Howard or Schaller et al. features, but doing so would be contrary to Bakalar's structure. Moreover features supposedly relied on by the Examiner are actually not to be found in either Howard or Schaller et al. Applicants pointed out that Howard locates his window construction in the window frame, not in front of a glass door or even in front of a window, and that in Schaller et al., the frame placed around their Venetian blind is itself fixed within a window frame, not in front of a glass door or even in front of a window, and further that Matimura adds nothing in this regard (or in any other relevant regard). Therefore, applicants believe they made a sound argument that there is no teaching, suggestion, or motivation to make the combination, either explicitly or implicitly, in the reference as clearly required by M.P.E.P. 2143.01. Because Bakalar is concerned only with freely suspended investitures, Howard and Schaller et al. are concerned only with frames fixed into window openings, and Matimura is concerned only with partition walls, there can be no teaching, suggestion, or motivation to combine any of these secondary references with Bakalar. See again M.P.E.P. 2143.01 for the well established principle that:

“[i]f a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Similarly, M.P.E.P. 2143.01 holds:

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) there the court held that the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.), precisely the situation here.

Accordingly, applicants have a sound basis for their position.

In any event, the claims under present consideration are specifically limited to structures in which the investiture in one of the sashes is a shutter and the investiture in the other sash is a mesh screen, which is completely out of the realm of teaching of the Examiner's references or any combination of them. That such claims are patentable is also testified to by the fact that the Written Opinion of the International Searching Authority (the U.S. Authority), finds that claims 24 – 26 (claim 27 was not before the searching authority) meet the criteria set out in PCT Article 33(2) – (3), because the prior art (which included Bakalar, Howard and Schaller et al.) does not teach or fairly suggest the claimed invention.

Applicants respectfully submit that the claims are in condition for allowance. A Notice of Allowance is respectfully solicited.

The Commissioner is hereby authorized to charge payment of any fees required associated with this communication or credit any overpayment to Deposit Account No. 50-0337. If an extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. 50-0337. A duplicate copy of this paper is enclosed.

Respectfully submitted,



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